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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/373,984	08/16/1999	XING SU	70862/93137	3179

7590 04/23/2002

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EXAMINER

TUNG, JOYCE

ART UNIT PAPER NUMBER

1637

DATE MAILED: 04/23/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/373,984

Applicant(s)

Su et al.

FILE

Examiner

Joyce Tung

Art Unit

1637



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Feb 8, 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-13, and 20-26 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-13, and 20-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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Response to Amendment

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1637.

1. The amendment filed 2/8/2002 has been entered.
2. Claims 5-8 and 10-22 remain provisionally rejected under the judicially created doctrine of obvious-type double patenting as being unpatentable over claims 1-17, 24-43 and 50-69 of copending Application No. 09/285,658 because the terminal disclaimer was not filed.
3. The rejection of claims 1, 3-13 and 20-25 under 35 U.S.C. §112, second paragraph are withdrawn because of the amendment.
4. Claims 1, 3-7 and 22-25 remain rejected under 35 U.S.C. §102 (b) anticipated by Sooknanan et al. (WO 96/17079).

Applicants argue that the method of Sooknanan et al. is for amplifying a specific nucleic acid sequence and further requires the presence of a terminal repeat in the template, while the instant method is for the amplifying a nucleic acid population. However, it is unclear what is the differences between the specific nucleic acid and a population of nucleic acid and the claim language does not have the requirement for a template. Applicants further argue that the method of Sooknanan et al. uses a single enzyme with both RNA and DNA dependent DNA polymerase activities. However, Sooknanan et al. also use four enzyme mixture (See pg. 8, first paragraph)

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Thus, Applicant's arguments filed 2/8/2002 have been fully considered but they are not persuasive.

The newly added claim 26 is also rejected under 35 U.S.C. §102 (b) anticipated by Sooknanan et al. (WO 96/17079) because the limitation anticipate the teachings of Sooknanan et al. (See pg. 32, last paragraph) since there is no limitation in the claim language on what is temperature range for the thermal stable polymerase.

5. Claims 8-13 remain rejected under 35 U.S.C. 103 (a) over Sooknanan et al. as applied to claims 1 and 3-7 and further in view of Kwoh et al. (Proc. Natl. Acad. Sci. USA, 1989, Vol. 86, pg. 1173-1177) and Goller et al. (Oncogene, 1998, Vol. 16, pg. 2945-2948).

Applicants argue that Kwoh et al. and Goller et al. do not remedy the deficiencies of Sooknanan et al. Claim 1 remains rejected under 35 U.S.C. §102 (b) anticipated by Sooknanan et al. (WO 96/17079) as indicated in section 4 above. Kwoh et al and Goller et al. disclose that the nucleic acid amplified is isolated from an eukaryotic cell or tissue as claimed in claims 8-13. The teachings of Kwoh et al. and Goller et al. would have motivated an ordinary skill in the art at the time of the instant invention to apply nucleic acid isolated from the cells or tissue. Thus, Applicant's arguments filed 2/8/2002 have been fully considered but they are not persuasive.

6. Claims 20-21 remain rejected 35 U.S.C. 103(a) as being unpatentable over Sooknanan et al. (WO 96/17079) as applied to claims 1 and 3-7 above, and further in view of Schnipelsky et al. (5,229,297).

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Schnipelsky et al. disclose an apparatus to amplify a nucleic acid sequence (See column 2, lines 17-24). The apparatus involves PCR thermocycler (See column 14, lines 7-9), an integrated reaction device and a robotic delivery system (See column 9, lines 26-60).

One of ordinary skill in the art at the time of the instant invention would have been motivated to apply the apparatus of Schnipelsky et al. to the method of Sooknanan et al. because the apparatus of Schnipelsky et al. can prevent sample from contamination (See column 2, lines 17-24). It would have prima facie obvious to carry out the method as claimed. Thus, Applicant's arguments filed 2/8/2002 have been fully considered but they are not persuasive

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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8. Any inquiries concerning this communication or earlier communications from the examiner should be directed to Joyce Tung whose telephone number is (703) 305-7112. The examiner can normally be reached on Monday-Friday from 8:00 AM-4:30 PM.

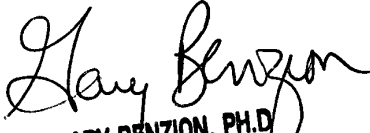
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached at (703) 308-1119 on Monday-Friday from 10:00 AM-6:00 PM.

Any inquiries of a general nature or relating to the status of this application should be directed to the Chemical/Matrix receptionist whose telephone number is (703) 308-0196.

9. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Art Unit 1656 via the PTO Fax Center located in Crystal Mall 1 using (703) 305-3014 or 308-4242. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989).

Joyce Tung

April 12, 2002


GARY BENZION, PH.D.
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600